UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,278	01/22/2002	Hiroya Kumashio	217967US2	7574

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EXAMINER
DULANEY, BENJAMIN O

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/051,278	KUMASHIO, HIROYA
	Examiner	Art Unit	
	Benjamin O. Dulaney	2625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *31 July 2006*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *2,4-9 and 11-13* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *2,4-9 and 11-13* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/31/2006 have been fully considered but they are

not persuasive. Responses to arguments are bolded below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

1)   Claims 2,4 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

Claims 2, 4 and 11 recite performing an action when "print condition settings are

incompatible with each other". The applicant's specification teaches only settings that

are inappropriate with each other, and neither that language nor the examples provided

in paragraph 41 suggest settings that cannot coexist without malfunction. They merely

suggest settings that if used together will not produced the best results.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2)   Claims 2, 4-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being

anticipated by U.S. patent 6,134,568 by Tonkin.

3)   Regarding claim 2, Tonkin teaches a printing system (Figure 1) having at least

one printer, comprising: a document supervisory client (Figure 1, item 31 or 32)

configures to generate print condition settings (Figures 5A-5F; Column 7, line 11 –

Column 8, line 53); and a document supervisory server (Figure 1, item 60) configured to

control printing based upon a printing request from the document supervisory client in

accordance with the print condition settings (Column 13, lines 1-24; Column 13, line 52-

Column 14, line 23); wherein said document supervisory client makes a query to the

document supervisory server via a network if the print condition settings are appropriate

in a printer (Column 9, line 24 – Column 10, line 43), said document supervisory server

returns advisability of the print condition settings to the document supervisory client

(Column 9, line 24 – Column 10, line 43), wherein said document supervisory server

changes a combination of the print condition settings (Column 9, line 24 – Column 10,

line 22) and sends an appropriate combination including one set of changed print

condition settings to the document supervisory client when determining the print

condition settings are incompatible with each other (Column 9, line 24 – Column 10, line

43), and wherein said document supervisory client generates a user interface based on the one set of changed print condition settings (Figures 8A-9).

In regards to applicant's argument that Tonkin does not teach determination of incompatibility between settings, examiner disagrees. After user selections are made in Tonkin, the data is then forwarded to the software for automated choosing of settings that have not been specified or only generally specified. In effect, the software receives selections, the data fields that were not entered by the user are determined "incompatible", and the program attempts to fill in these gaps in order to proceed to printing. Sometimes the program fails to provide a compatible setting (as detailed by column 10, lines 20-22), but at all other times compatible settings are returned by the "supervisory server".

4)   Regarding claim 4, Tonkin teaches a printing system, comprising: a first computer including a document supervisory client configured to generate print condition settings (Figures 5A-5F; Column 7, line 11 – Column 8, line 53); and a second computer including a document supervisory server configured to perform printing base upon a printing request from the document supervisory client in accordance with the print condition settings (Column 13, lines 1-24; Column 13, line 52- Column 14, line 23); at least one printer connected to a network (Figure 1); wherein said document supervisory client makes a query to the document supervisory server via a network if the print condition settings are appropriate in a printer (Column 9, line 24 – Column 10, line 43), said document supervisory server returns advisability of the print condition settings to the document supervisory client (Column 9, line 24 – Column 10, line 43), wherein said

document supervisory server changes a combination of the print condition settings

(Column 9, line 24 – Column 10, line 22) and sends an appropriate combination

including one set of changed print condition settings to the document supervisory client

when determining the print condition settings are incompatible with each other (Column

9, line 24 – Column 10, line 43), and wherein said document supervisory client

generates a user interface based on the one set of changed print condition settings

(Figures 8A-9).

5)   Regarding claim 5, Tonkin teaches the printing system according to claim 2,

wherein said document supervisory server sends initial setting values with applicable

character strings and graphs each representing print condition settings to the document

supervisory client, and said document supervisory client generates a user interface

configured to allow print condition settings based upon the setting values, character

strings, and graphs (Column 13, lines 1-24; Column 9, line 24 – Column 10, line 43).

6)   Regarding claim 6, Tonkin teaches the printing system according to claim 5,

wherein, said document supervisory server changes a combination of the print condition

settings and sends an appropriate combination including one set of changed print

condition settings to the document supervisory client when determining the print

condition settings are an inappropriate combination (Column 9, line 24 – Column 10,

line 43).

7)   Regarding claim 7, Tonkin teaches the printing system according to claim 4,

wherein said document supervisory server sends initial setting values with applicable

character strings and graphs each representing print condition settings to the document

supervisory client, and said document supervisory client generates a user interface
configured to allow print condition settings based upon the setting values, character
strings, and graphs (Column 13, lines 1-24; Column 9, line 24 – Column 10, line 43).

8)   Regarding claim 8, Tonkin teaches the printing system according to claim 7,
wherein, said document supervisory server changes a combination of the print condition
settings and sends an appropriate combination including one set of changed print
condition settings to the document supervisory client when determining the print
condition settings are an inappropriate combination (Column 9, line 24 – Column 10,
line 43).

9)   Regarding claim 9, Tonkin teaches the printing system according to any one of
claims 4 to 8, wherein, said document supervisory client is configured to send an ID
which uniquely identifies a document stored in a database in a document supervisory
server (Column 6, line 51 – Column 7, line 27; Column 13, lines 26-64), and said
document supervisory server obtains an applicable document corresponding to the ID
and executes printing the applicable document in accordance with the print condition
settings (Column 13, line 26 – Column 14, line 23).

10)   Claim 11 is rejected in the same manner as claim 2.

11)   Claim 12 is rejected in the same manner as claim 5.

12)   Claim 13 is rejected in the same manner as claim 9.
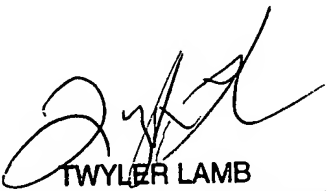
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin O. Dulaney whose telephone number is (571) 272-2874. The examiner can normally be reached on Monday - Friday (9am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TWYLER LAMB
SUPERVISORY PATENT EXAMINER